

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Skszek et al

Serial No.: 09/851,601

Group No.: 1762

Filed: May 9, 2001

Examiner: E. Fuller

For: FABRICATION OF ALLOY VARIANT STRUCTURES USING DIRECT METAL DEPOSITION

PETITION TO EXAMINE CLAIMS 6-10

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

MAY 27 2003

Dear Sir:

TC 1700

In response to the final Office Action mailed March 19, 2003, Applicants hereby petition to have claims 6-10 examined.

Facts

In January, 2003, Applicants attempted to add claims 6-10 in the above-referenced patent application, these claims being dependent on method claims 1-5, respectively. Each claim in question is a product-by-process claim, reciting, "tooling fabricated in accordance with a method" of claim 1, 2, 3, and so on.

The Examiner took it upon himself to restrict out Applicants' attempt to add the claims, on the grounds that "the inventions are related as process of making and product made." Following the usual boilerplate language, the Examiner states that "in the instant case, a process that does not optically monitor the physical dimensions of the tooling during fabrication may be used to make a product that is patentably identical to that of claims 6-10." The Examiner has absolutely no foundation for this statement, and it is believed by the undersigned to be calculated only to avoid examination of Applicants' claims, currently under final rejection. Query: how does the Examiner know that "a process that does not optically monitor the physical dimensions of the tooling during fabrication may be used to make a product that is patentably identical to that of claims 6-10"? The answer is that the Examiner does not know, or could not know of any process to do so, since the dependent claims proposed by

Applicants do just that -- *they depend from other claims including certain limitations*. Thus, assuming that the use of "optical monitoring" as set forth in the claims currently under rejection represents some sort of improvement which would enhance the physical dimensions of the tooling during fabrication, the tooling set forth in the proposed claims *could only be made* by the process set forth in the claims from which they depend.

In summation, unless the Examiner can prove that a different process could be used to make the tooling set forth in Applicants' proposed product-by-process claims, Applicants respectfully request that this case be remanded to the Examiner to examine claims which Applicant proposes to add. A fee of \$130 is enclosed herewith in accordance with 37 CFR §1.17(h).

Respectfully submitted,

By: 

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Date: May 19, 2003

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date indicated below and is addressed to: Mail Stop Petitions, Commissioner for Patents, PO 1450, Alexandria, VA 22313-1450.

Date: 5/19/03


Sheryl L. Hammer